

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
January 12, 2004
Paper No. 23
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

McKay H. Davis

v.

Emblematic Corporation

Cancellation No. 92029720
to Registration No. 1974518

Lynn G. Foster of Foster & Foster L.L.C. for McKay H.
Davis.

Bill B. Berryhill for Emblematic Corporation.

Before Bucher, Bottorff and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

On November 22, 1999, McKay H. Davis (Petitioner)
filed a petition to cancel Registration No. 1974518, owned
by Emblematic Corporation (Respondent). This registration
is for the mark KOKOPELLI and design, as shown below:



The involved registration issued on May 21, 1996, as a result of an application filed on March 25, 1994. The goods in the registration are identified as "bags, namely handbags and tote bags," in International Class 18, and "clothing, namely sport shorts, T-shirts, sweat shirts, fashion knit shirts, jackets, caps, hats, scarves, socks, sleep wear and gloves," in International Class 25. The registration alleges dates of first use and dates of first use in commerce, for both classes, of February 1994.¹

Petitioner claims that he has promoted a variety of Kokopelli figures as used in connection with key chains and decals, since at least as early as fall of 1991, and T-shirts at least as early as spring of 1992. Petitioner filed an application for a Kokopelli figure riding a bicycle, as shown below, for goods identified in the application as key chains, decals and shirts:

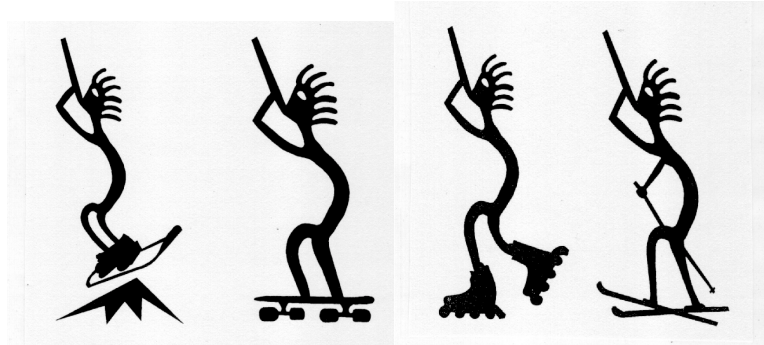


2

¹ The Section 8 affidavit for Registration No. 1974518 was accepted in September 2002.

² Application Serial Number No. 75482477 was filed on May 11, 1998, and remains suspended awaiting the outcome of the instant proceeding.

Similarly, petitioner alleges that since at least as early as 1992, he has distributed key chains, decals and shirts which feature designs (as shown below) depicting a Kokopelli character riding on or using a snowboard, skateboard, inline skates and skis:



Accordingly, petitioner alleges that when registrant's similar mark is used on its identified goods, there is a likelihood of confusion and therefore, he seeks the cancellation of respondent's registration. In its answer, respondent denied the salient allegations of the petition to cancel, and argues laches as an affirmative defense. Both parties have fully briefed the case but no oral hearing was requested.

The record consists of the file of the involved registration, and petitioner's trial testimony depositions, with accompanying exhibits, of McKay H. Davis (petitioner) and of Charles C. Fallon, Jr., team manager for Pacific

Cycle. Respondent took no testimony and placed no evidence in the record during its testimony period.

As a preliminary matter, we address petitioner's motion to strike certain evidentiary assertions in respondent's appeal brief. While respondent's involved registration file is automatically part of the record, petitioner is correct in arguing that this does not mean that allegations contained in the registration file wrapper are evidence on behalf of the registrant/respondent in the current *inter partes* proceeding. See 37 CFR §2.122(b)(2). Because respondent introduced no evidence during its testimony period, all arguments made in respondent's brief based upon the specimens, documents, exhibits, etc., contained within the registration file have not been considered.

Additionally, although respondent raised laches as an affirmative defense in its answer, respondent placed no evidence into the record during its testimony period and failed to raise this argument in its trial brief. Accordingly, we have given this defense no further consideration.

Finally, while the initial petition contained dilution language, and petitioner's earlier motion for summary judgment argued that respondent's mark is primarily

geographically descriptive, neither of these allegations has been tried, and we have given them no consideration.

The record establishes petitioner's standing to bring this petition to cancel, both through petitioner's proof of use of the term "Kokopelli" and use of the image of a Kokopelli character in association with shirts, and proof of its ownership of a pending application that has been rejected on the basis of the involved registration.

Proof of a prior proprietary right is, of course, a requirement for petitioner to prevail herein. Petitioner's assertion of prior trademark rights raises two separate but related inquiries. The first question is one of priority - whether or not petitioner has shown with competent evidence use of various Kokopelli designations on the claimed goods prior to the earliest dates on which respondent can rely.

In determining priority in this case, we must also consider the issue of the distinctiveness, either inherently or through acquired distinctiveness, of the designation claimed by petitioner to be his mark. In light of respondent's allegations as to the ornamental manner in which petitioner's various Kokopelli characters have been used, we cannot presume this image is inherently distinctive for petitioner's shirts, for example. Hence, the second critical question is whether petitioner's

Kokopelli designations have actually acquired distinctiveness as source indicators. See Otto Roth & Company, Inc. v. Universal Foods Corporation, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981); see also Towers v. Advent Software Inc., 913 F.2d 942, 17 USPQ2d 1471 (Fed. Cir. 1990). We must evaluate the evidence of record to determine whether petitioner has established acquired distinctiveness of his mark as required by Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 54 USPQ2d 1065 (S.Ct. 2000).

Turning first to the basic question of whether petitioner has demonstrated his priority, the record establishes that petitioner used the term Kokopelli along with images of a Kokopelli character on T-shirts as of the spring of 1992. (Trial deposition of McKay H. Davis, pp. 6 - 8) This is a date prior to the filing date of the application that matured into respondent's registration, namely March 25, 1994.³ Thus, in this case, priority rests with petitioner.

Nonetheless, in order for this use to be legally significant, we must determine whether the term Kokopelli

³ It is also prior to respondent's claimed date of first use of February 1994.

and the various Kokopelli images have actually functioned as distinctive source indicators for petitioner.

The record shows the image of petitioner's walking stick figure on the front side of a T-shirt:



as well as a Kokopelli character riding a bicycle off an arch in the same scene as the word Kokopelli on the back side of the same shirt:



The record contains information about the history of this character from a variety of sources, including petitioner's own promotional pieces:

American Southwest legends tell of the mythical humped back flute player, KOKOPELLI[, who] was said to wander from village to village with a bag of songs on his back, and as a symbol of fertility he was particularly [sic] welcome during the corn planting season.

Today, KOKOPELLI has been adopted as the patron saint of mountain bikers and s/he who dons his image shall be protected.

As argued by respondent in its brief, we find that given the way petitioner's promotes the personality and character of the Kokopelli character, and fits the actions of this icon into a much larger thematic whole, petitioner's alleged mark is nothing more than mere ornamentation. See In re Astro-Gods Inc., 223 USPQ 621 (TTAB 1984). Clearly, the alleged mark serves as part of the aesthetic ornamentation of these goods. On the front of the T-shirt, the Kokopelli character is approaching another stick figure down on all fours, both silhouetted against a semi circle reminiscent of a setting sun. On the back of the shirt, the Kokopelli character is riding a bicycle down the side of a fanciful representation of the Delicate Arch, with the word "Kokopelli" emblazoned across the front of the arch - arguably performing a non-trademark function of identifying the bike-riding character by name.

Petitioner's own literature connects the "spirit" of outdoor biking fun with the "action" and "personality" of this well-known icon:

Outdoor recreation fans everywhere are customizing vehicle windows and roof spoilers with stickers. Our copyrighted Kokopelli series of stickers capture the spirit of outdoor fun best with the appearance of action. No other character has the fantastic personality of the one and only kokopelli, native of Moab, mountain bike mecca of the world

Rather than building trademark rights in this matter, petitioner himself appears to be encouraging bikers to buy his shirts, key rings and stickers because they depict an animated version of the popular Native American icon, Kokopelli, without attempting to tie this imagery to one particular source of the goods.

In this vein, although this testimony was introduced by petitioner as evidence of actual confusion between petitioner's and respondent's usage, the testimony of a racing team manager, Charles C. Fallon, Jr., seemed to suggest a growing proliferation of Kokopelli images on T-shirts around the Moab racing scene, and elsewhere:

Q: Have you ever seen a Kokopelli and a Kokopelli image on a T-shirt coming from anybody other than McKay Davis?

A: Well, I have seen stuff over the years - you know - I have seen stuff - you know - in Moab and places like that you see - you know

- you are starting to see this guy
[Kokopelli images] all over the place....

Against this backdrop, the record put together by petitioner contains nothing in the form of evidence of the dollar volume of petitioner's sales of his key chains, decals and T-shirts, or the dollar amount of his promotional expenditures over the past decade for goods bearing his alleged Kokopelli mark.

Accordingly, we find that on the record before us, petitioner has not proven his allegation that the Kokopelli designation has become exclusively associated with petitioner through his uses of Kokopelli images. Because petitioner has not proven that he has prior rights in Kokopelli, he cannot succeed on his claim under Section 2(d) and we need not discuss the application of the du Pont factors⁴ to the question of likelihood of confusion herein.

However, even though it is not necessary for us to decide the question of likelihood of confusion in light of the disposition above, in the interest of completeness and judicial economy (e.g., in the event petitioner should appeal our finding of an absence of distinctiveness, and were to prevail on that issue), we should comment on several key du Pont factors.

As to the du Pont factors focusing on the confusing similarity of the marks, petitioner's Kokopelli image is of a skinny, elongated character, which stands in stark contrast to the short, stocky Kokopelli character shown in respondent's registration. Furthermore, there is no showing that petitioner's mark is strong. To the contrary, petitioner's own evidence in the record suggests a degree of weakness for this matter as a source identifier. This designation traces its origins to the prehistory of Native Americans in the American Southwest, and the record suggests the increasing popularity of images of the Kokopelli character on T-shirts and other items from the four-corners area of the American Southwest. Moreover, petitioner has further handicapped its position by employing so many variations on the theme (e.g., the bicycle-riding Kokopelli facing right at times and left at others; riding on or using a bicycle, snowboard, skateboard, inline skates and skis; incorporating the Kokopelli character into a composite image in close proximity to another stick figure; etc.). Hence, given the seeming weakness of the Kokopelli character as a source identifier, and taking into consideration the striking

⁴ Drawn from In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

differences in the overall commercial impressions of petitioner's and respondent's characters, we find that even if petitioner were to demonstrate acquired distinctiveness of its ornamental character, petitioner would still fail in this proceeding to demonstrate a confusing similarity with respondent's mark.

Finally, as to the du Pont factor focusing on the relationship of the respective goods, while petitioner's T-shirts are deemed to be identical to the T-shirts listed in respondent's registration, and T-shirts are related to the other International Class 25 goods identified in respondent's registration, there has been no showing of the relationship of T-shirts, key chains or decals to respondent's bags in International Class 18, namely its "handbags and tote bags."

Accordingly, inasmuch as petitioner is the party who bears the burden of proof in this proceeding, and because petitioner has failed to demonstrate that he has prior proprietary rights in the Kokopelli design, he cannot succeed on his claim under Section 2(d) and it is adjudged that the petition to cancel must fail.

Decision: The petition to cancel is hereby denied.